

REMARKS

Elected claims 1, 2, 11, 12 and 26-41 remain pending for further prosecution in the present application. Non-elected method claims 5, 6 and 42-49 are withdrawn; however, the method claims remain in the present application for the possibility of rejoinder. The claims of the present application have been amended to overcome the rejections stated in the Office Action. Accordingly, Applicants respectfully submit that the claims distinguish over the prior art of record and that the present application is in condition for allowance.

I. Election/Restriction

In the non-final Office Action dated October 16, 2009, confirmation of the election of the Group I product claims is requested.

Applicants confirm the election of the Group I product claims for prosecution in the present application. The Group I product claims include claims 1, 2, 11, 12 and 26-41.

Request for Rejoinder

Should elected independent claim 1 of the present application be allowed, Applicants respectfully request rejoinder of non-elected process claims 5, 6 and 42-49. Method claims 5 and 6 have been amended to require methods of manufacturing the powder or film according to claim 1. No new matter was added. Thus, all the method claims include all the limitations of elected independent claim 1.

II. Objection of Specification

In the non-final Office Action dated October 16, 2009, page 3 of the specification was objected to on the basis that "the incorporation by reference is objected to as these documents have not been made of record for consideration (as instructed by the specification) and on their own merits."

On page 3 of the present application, Non-Patent Documents Nos. 1 to 4 and Patent Document No. 1 are listed. These documents and their disclosures are briefly discussed in the background section of the present application on pages 2-3, as filed. The references are not incorporated by reference; rather, they are merely cited for purposes of providing background.

A Supplemental Information Disclosure Statement is being filed herewith and includes full copies of Non-Patent Documents Nos. 2, 3 and 4 and an Abstract for Non-Patent Document No. 1.

With respect to Patent Document No. 1 (Japanese Patent Application No. 2003-386694), it is one of the priority applications to which the present application claims a benefit of priority. The present application is the U.S. national phase of International PCT Application No. PCT/JP2004/016981. This International PCT application claims a benefit of priority to Japanese Patent Application Nos. 2003-386694 and 2004-271984. Thus, Patent Document No. 1 refers to the Japanese priority application of the present U.S. national phase application. Copies of the priority documents have been submitted by Applicants as required during the International phase of the present application.

For the above reasons, Applicants respectfully request reconsideration and removal of the above referenced objection to the specification.

III. Objection to the Claims

In the non-final Office Action dated October 16, 2009, claims 12 and 27-30 are objected to with respect to minor formalities.

The minor formalities with respect to claims 12 and 27-30 identified on page 4 of the Office Action have been corrected. No new matter was added.

Accordingly, Applicants respectfully request reconsideration and removal of the above referenced objection to claims 12 and 27-30.

IV. Claim Rejections – 35 USC §112, second paragraph

In the non-final Office Action dated October 16, 2009, claims 1, 2, 12, 29, 30, 33 and 38-41 are rejected under 35 USC §112, second paragraph, as being indefinite.

The following claims amendments have been made with respect to the above referenced rejection. The word “thin” as used in the phrase “thin film” has been deleted throughout the claims. In claim 12, the word “pores” has been replaced with “mesopores”. In claim 30, the word “dissimilar” has been deleted. In claim 33, the “active oxides” have been specified (no new matter was added; for example, see the oxides listed in claim 28).

With respect to the limitation “the glass phase” as recited in claims 29 and 30, claim 11 has been amended such that it depends from independent claim 1. Claim 1 recites “a glass phase”. Accordingly, since claims 29 and 30 now depend via claim 11 to base independent claim 1, proper antecedent basis is now provided for the limitation “the glass phase” recited in claims 29 and 30.

Accordingly, Applicants respectfully request reconsideration and removal of the above referenced indefiniteness rejection of claims 1, 2, 12, 29, 30, 33 and 38-41.

V. Claim Rejections – 35 USC §103(a)

In the non-final Office Action dated October 16, 2009, claims 11, 12, 26, 27, 29 and 31-37 are rejected under 35 USC §103(a) as being obvious in view of U.S. Patent Application No. 2004/0126659 A1 of Graetz et al. in view of U.S. Patent No. 7,087,348 B2 issued to Holman et al.

Independent claim 11, as filed, has been amended to depend from base independent claim

1. No new matter was added. Thus, claim 11 now reads as follows:

“Claim 11 (currently amended): A secondary battery having said nanocrystal oxide-glass mesoporous composite film according to claim 1, said film forming a nanocrystal oxide-glass mesoporous composite electrode of said secondary battery.”

Independent claim 1 requires a nanocrystal oxide-glass mesoporous composite powder or film having a three-dimensional structure with regularly arranged mesopores and in which a glass phase contains P_2O_5 . In the Office Action, it is indicated that claim 1 is allowable over the above cited prior art.

Accordingly, since claim 1 is patentable over the above cited references and since claim 11 has been amended to depend from claim 1, Applicants respectfully request reconsideration and removal of the above stated obviousness rejection of claims 11, 12, 26, 27, 29 and 31-37.

VI. Allowable Subject Matter

In the Office Action dated October 16, 2009, claims 1, 2 and 38-41 are stated as being allowable if rewritten or amended to overcome the rejections under §112, second paragraph.

Independent claims 1 and 2 have been amended to overcome the §112, second paragraph, rejection. All other claims depend directly or indirectly from one of base independent claims 1 or 2.

Accordingly, Applicants respectfully submit that elected claims 1, 2, 11, 12 and 26-41 are in condition for allowance. In addition, Applicants respectfully request rejoinder of non-elected method claims 5, 6 and 42-49.

VII. Conclusion

In view of the above amendments and remarks, Applicants respectfully submit that the rejections have been overcome and that the present application is in condition for allowance. Thus, a favorable action on the merits is therefore requested.

Please charge any deficiency or credit any overpayment for entering this Amendment to our deposit account no. 08-3040.

Respectfully submitted,
Howson & Howson LLP
Attorneys for Applicants

By /William Bak/
William Bak
Reg. No. 37,277
501 Office Center Drive
Suite 210
Fort Washington, PA 19034
(215) 540-9216